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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.								
10/619,044	07/14/2003	John M. Meyer JR.	7779	6067								
22922 7590 01/15/2008 REINHART BOERNER VAN DEUREN S.C. ATTN: LINDA KASULKE, DOCKET COORDINATOR 1000 NORTH WATER STREET SUITE 2100 MILWAUKEE, WI 53202			<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">SAYALA, CHHAYA D</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>1794</td><td></td></tr></table>		EXAMINER		SAYALA, CHHAYA D		ART UNIT	PAPER NUMBER	1794	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/619,044

Applicant(s)

MEYER ET AL.

Examiner

C. SAYALA

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-7 and 10-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-7, 10-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/11/2007 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1, 4-7, 10-37 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's amended claims recite "said hides or skins being free of animal blood". The specification as originally filed has been carefully reviewed (with Microsoft Word search) and there is no support found for such a limitation. Upon applicant pointing out where such a description can be found, the rejection will be withdrawn.

Note that in particular claim 1, the starting material is hides or skins being free of animal blood. Such a concept where applicant starts the process by using skins or hides free of blood needs to be supported by the specification as originally filed.

Claim Rejections - 35 USC § 102/ Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 32, 34 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated or, in the alternative, under 35 U.S.C. 103(a) as obvious over Coody (US Patent 5007194), Yearley (US Patent 2102052) and Carr (US Patent 4463018).

The above references teach a bait that is made from rind or hide. The claims recite “crustacean bait” and such terminology is considered “use” terminology. The rejection is being made under both statutes due to applicant’s independent claims. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a

product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted)

"[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). As for claims 34 and 36, which are based on the independent claims that recite "edible" bait, since the references also teach a bait from rind/hide, then it must also be edible, even though the reference does not explicitly state that this is the case.

3. Claims 1, 4-7, 10-29, 31-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams Jr. (US Patent 3964203) and Carr (US Patent 4463018) in view of Pfleiderer et al. (US Patent 4484924), Hague et al. (US Patent 6827041) and Talty et al. (US Patent 3408918) and further in view of Thiele (US Patent 4224028).

Using rinds/skins as fishing lures were known in the art at the time the invention was made. See for instance Williams, Jr, who teaches the use of pork rind in prior art and chamois in the reference invention, the latter being treated with cod-fish oil. The chamois is cut into strips and the strips have an attachment hole at one end for a fish hook. See claims. Carr also describes using hide with artificial bait incorporated with an attractant such as fish-oil and that can be used in traps or pots (col. 4, lines 40-41). The patents do not teach the other steps of treating with alkali, washing, deliming etc.

Pfleiderer et al. teach washing hides/skins for the removal of dirt, soaking in hydrated lime or alkalies to a pH of from 7-11, deliming with acids such as citric acid and finally, curing with NaCl. See col. 6, e.g. 1; col. 5, lines 16; col. 2, line 40, which teaches that mixing/washing can be done in a drum or in a mixer. Note too that in the soak liquor containing alkali that brings the pH value to between 8 and 10 (see line 63), "wetting agents" (detergents) are used. Thus all the steps were known in the art at the time the invention was made.

To substantiate this fact, see Hague et al. who teach that skin is washed with alkali, washed with salts such as ammonium chloride, and then bleached. See col. 5, lines 3-10, which show the fat and oil is removed by agitating with sodium salts. The

degrease materials can also be a detergent, and the skin is bleached so that the skin is low in oil, and is soft. See example 1. At col. 4, the patentees teach that the skins are agitated in alkali in drums that have agitators in them typically in the forms of ribs that lift the skins and drop them. The skins are then washed and alkali is removed with ammonium chloride. The skins are rinsed at this stage for 0.5 to 3 hours. The first step of alkali treatment and washing is done at 10-40°C. The patent states "The two steps for removing the alkali can vary in time and depend on the concentration and quantity of the chemicals, the temperature of the components inside the drum and the speed that the drum turns. The worker or operator can adjust the times as needed." Although the patent does not teach the temperature used for deliming, to follow the guidance provided by the above patent would have been obvious to one of ordinary skill in the art, and therefore to use the same temperature range and adjust the times as needed would have been obvious. Talty et al., also drawn to processing of hides, show liming for a period of less than 4 days for periods of 3-12 hours or less, which reads on the limitation claimed instantly. The hide pieces are then neutralized with acids such as citric acid (see col. 3). The delimed, washed hides are then further processed to final products. Note that the above references do not expressly state that blood was removed, however, one of ordinary skill in the art in considering the processes of these references, would have the reasonable expectation that blood would be removed because of the use of reactants/processes such as alkali washing, deliming, bleaching, detergents, etc.

These references add to the disclosure of Pfleiderer et al. that processing steps from skin or hide to remove fat, flesh, hair and to bleach the skin or hide so as to form the final product were similar. Note that although only a few of the limitations pertaining to amounts, and time and temperature of wash/rinse water are disclosed as claimed, such determinations would depend primarily on the type and volume/weight of skin and hide, and end product use. To make minor modifications to known process steps shown by the references of Pfleiderer et al., Hague et al. and Talty et al. so as to prepare an artificial lure, to incorporate an attractant into the lure such as fish oil, a known fish attractant, would have been obvious to the practitioner at the time the invention was made. To add steps such as checking pH of the acid solution, draining washing solutions, adding more water or alkali or acid if more is necessary or to adjust such levels to below a particular required value, are steps that would have been routine and obvious to the skilled worker, barring any evidence to the contrary. To use temperatures of rinse liquids above 100° C also would also have been obvious for the logical scientific fact of removing fat and grease with warm water and adding to the degrease effect that one of ordinary skill would have associated with the degrease techniques used above with respect to the chemicals disclosed.

As for packaging the artificial lures, this limitation has been in use in prior art as shown by Carr (see col. 6). To choose plastic containers and to pack the attractant also with the bait would have been an obvious modification over applying the oil to the rawhide and then packing it. Disclosure of fish oil renders obvious all the specific oils claimed.

Artificial lures use rawhides, hides or skins, as shown by prior art and the process steps of liming, deliming, rinsing, bleaching, curing etc. such hides or skins are also known in the art, and the motivation to use such processes to prepare such artificial bait is to primarily clean them and to convert them to be stable, to prevent and/or retard putrefaction of skins, hides of freshly slaughtered animals. See Thiele. See col. 2, in Thiele, and though this patent is drawn to the tanning industry, the artisan would have recognized that in preparation of rawhide for a bait, the same problems exist because decay, putrefaction would have been inherent disadvantages to both utilities. As for claims 34 and 36, which are based on the independent claims that recite "edible" bait, since the references also teaches a bait from rind/hide, then it must also be edible, even though the reference may not explicitly state that this is the case.

4. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams Jr. (US Patent 3964203) and Carr (US Patent 4463018) in view of Pfleiderer et al. (US Patent 4484924), Hague et al. (US Patent 6827041) and Talty et al. (US Patent 3408918) and further in view of Gould (US Patent 3670534) and Holdsworth (US Patent 3913360).

Although Hague et al. teach that the skins are agitated in alkali in drums that have agitators in them typically in the forms of ribs that lift the skins and drop them and Pfleiderer et al. teach a mixer for processing hides and rinds, they do not disclose any particular device. Mixing devices with respect to processing hides are disclosed by Holdsworth and Gould. To adjust the blades in a manner that would provide the

necessary mixing, given the prior art devices and their blades would have been within the ambit of ordinary skill. When the primary reference teaches that "a mixer" was used, it is prima facie obvious to select a mixer/device from a reference that pertains to the same endeavor: processing hides.

Response to Arguments

Applicant's arguments filed 5/11/2007 have been fully considered but they are not persuasive.

The traversals on pages 10-11 criticizing Yearley, Carr and Coody discuss the various teachings of the references. For instance, Yearley has been criticized as showing pork rind bait, Carr as showing an artificial bait and Coody showing sheepskin lure material. However, the claims are in a product-by-process format and therefore, are product claims. The claims read on a crustacean bait, crustacean being use terminology. Applicant's criticism that the sheepskin includes hair, or that Carr teaches an artificial bait or that Yearley is to pork rind bait does not establish patentability because there is nothing in these product claims that exclude such features. Carr teaches a non-live natural bait that is used in conjunction with the artificial bait, see col. 4, lines 35-40.

With regard to the other references, applicant's arguments against the references individually, has been noted but it is well established that one cannot show

nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Williams, Jr. has been used to show the use of pork rind and chamois, that it can be cut into strips with an attachment hole at one end for a fish hook. If the reference had taught the processing steps pointed out by applicant, which has been criticized as being absent, then the reference would have been used under 35 USC 102.

Carr is important in showing the aspect of the invention which pertains to using a non-live natural bait with an artificial bait, fish oil as an attractant and using the bait in traps or pots. It is the only showing that is important in its use here.

Pfleiderer et al. teaches an enzyme or sulfide in the presence of alkali, and not as applicant has characterized this reference. It should be noted that none of these additives is excluded by the claims. As such, the temperature applicant refers to would not affect the process when sulfides are present. See claim 4. Applicant also states that the utility of the patent is different. This patent is being relied on for its teaching that pertains to cleaning of the hides and skins, which would be important whether the skin or hide is used for shoes or baits, i.e. irrelevant of its utility with the implicit intent that cleaning and preparing hides would be applicable here too. Even if the utility is not the absolute same, see *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering

his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved). See MPEP § 2141.01(a).

The same argument holds good for the remaining references that applicant states do not teach *all* the limitations claimed herein and are non-analogous in nature. Such references have been used for specific teachings that one would have considered as beneficial and pertinent in the preparation of hides or skin, whether they are used as casing, shoes or bait. Furthermore applicant has unduly limited his view of all that each reference would have fairly suggested to a person having ordinary skill in this art. Under 35 USC 103, a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests. In re Burckel, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979).

Applicant has stated at pages 14-15 that the references are unrelated in utility, that there is no motivation to combine them, and that the examiner has used improper hindsight. Each of the references of Pfleiderer and Hague et al. are related to cleaning skins, therefore these two references point to similar processes and chemicals in cleaning hides and therefore, are combinable and the skilled worker who is looking to find processes to clean and prepare hides would have known to combine them since their teachings reinforce each other. Talty is used only for its showing of the time

required for processing of hides and therefore is important and useful for such disclosure. The motivation to combine such references would have been obvious since the teachings present a comprehensive process with all the innumerable limitations of the instant claims that would produce a method of preparing hides as claimed for bait material. The references show that these innumerable limitations were already being practiced in the prior art at the time of filing and applicant appears to have picked and chosen such limitations already existing in prior art and combined them. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. SAYALA, Ph.D. whose telephone number is 571-272-1405.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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